

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: Philip Course *et al.*
Application Serial No.: 10/562,314
Filing Date: 05/19/2006
Title: **Electronic Transaction System**
Examiner: Augustin, Evens J.
Art Unit: 3621
Atty. Docket No.: 72882-012 (WRAJ-002)
Confirmation No.: 3803
Customer No.: 23630

APPEAL BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed 22 July 2011, wherein Appellant appeals from the Examiner's final rejection of claims 1-30 of the subject application as set forth in the final Office Action of 22 January 2010.

Real Party In Interest

The subject application is assigned to TAMFO Australia Pty Ltd., by assignment executed 01 May 2006 and recorded on 19 May 2006, at Reel 017642, Frame 0773.

Related Appeals and Interferences

To the best of Appellant's and Appellant's representatives' knowledge, there are no related appeals or interferences (see Related Proceedings Appendix).

Status of Claims

1. Claims canceled: None
2. Claims withdrawn from consideration, but not canceled: 31-42
3. Claims pending: 1-42
4. Claims allowed: None
5. Claims rejected: 1-30
6. Claims on appeal: 1-30

Status of Amendments

No amendments have been filed subsequent to the final Office Action of 22 January 2010.

Summary of Claimed Subject Matter

The following is a summary of the claimed subject matter, with supporting citations provided relative to the specification of the subject application as filed. The supporting citations are representative; other support for the claimed subject matter may be present in the subject application.

A. Summary of Independent Claims

Claim 1

Independent claim 1 of the subject application recites an electronic transaction system comprising:

a host server (page 10, line 7) having an electronic inventory of electronic goods and/or services (page 5, line 24 through page 6, line 5);

at least one transaction device (page 10, line 8) having a transaction application (page 16, lines 14-18);

at least one service provider system (page 10, line 9);

a content management system (page 10, line 12),

where the content management system provides content in the form of details of electronic goods and/or services stored in the electronic inventory able to be transacted by the electronic transaction system to the at least one transaction device (page 3, lines 4-6) and where the transaction application is operable to generate a user interface using the details and operable to generate a client request for one or more of the electronic goods and/or services (page 16, line 13 through page 17, line 14 and page 25, lines 7-9), where upon the at least one transaction device issuing the generated client request to the host server the host server operates to generate a client response in reply to the client request and in generating the client response, where necessary, issuing a service request to the at least one service provider system and receiving a service response from the at least one service provider (page 3, lines 6-12), and to issue the

requested electronic goods and/or services (page 11, line 9 and page 12, line 9 through page 14, line 21).

B. Identification of Means/Step Plus Function

No means plus function or step plus function limitations are recited in the claims on appeal.

Grounds of Rejection To Be Reviewed On Appeal

I. Whether claims 1-30 are anticipated under 35 U.S.C. § 102(e) by U.S. Patent Application Publication No. U.S. 2002/0143655 to Elston *et al.* (“Elston”).

Argument

I. Claims 1-30 are not anticipated under 35 U.S.C. § 102(e)

In the final Office Action of 22 January 2010 issued for the subject application, claims 1-30 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. U.S. 2002/0143655 to Elston *et al.* (“Elston”).

Appellant respectfully submits that claims 1-30 are not anticipated or rendered obvious by Elston, as is explained below.

Appellant submits that to anticipate a claim, the reference must teach every element as set forth in the claim. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference”. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)

(*see also* MPEP §2131). Furthermore, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); *see also* MPEP § 2143.03.

Claim 1 of the subject application recites the following:

1. An electronic transaction system comprising:

- a host server having an electronic inventory of electronic goods and/or services;
- at least one transaction device having a transaction application;
- at least one service provider system; and
- a content management system,

where the content management system provides content in the form of details of electronic goods and/or services stored in the electronic inventory able to be transacted by the electronic transaction system to the at least one transaction device and where the transaction application is operable to generate a user interface using the details and operable to generate a client request for one or more of the electronic goods and/or services, where upon the at least one transaction device issuing the generated client request to the host server the host server operates to generate a client response in reply to the client request and in generating the client response, where necessary, issuing a service request to the at least one service provider system and receiving a service response from the at least one service provider, and to issue the requested electronic goods and/or services.

The electronic goods and/or services recited in Appellant’s claims, e.g., claim 1, may take the form of movie pass numbers, recharge codes for telecommunications carriers or software (*see*

page 14, lines 23 to 25 of the specification, which corresponds to PCT publication number WO 2005/001725). The transaction application generates a user interface through which a customer interacts to purchase an electronic good or service (*see* page 25, lines 7 to 9 of the specification). Once the customer's selection has been completed using the user interface, the transaction device generates a client request for the selected electronic good or service and the client request is forwarded to the host server 12 (*see* page 25, lines 10 to 23 of the specification). The client request is then processed and ultimately the host server is operable to issue the requested electronic good or service to the transaction device (and thus to the customer) (*see* page 30, lines 9 to 19 of the specification as filed).

Elston fails to disclose or suggest at least the above-mentioned features of claim 1 and the above-described aspect of the claimed invention.

In particular, Elston's system does not relate to an electronic transaction system capable of transacting electronic goods and/or services. In fact, Elston clearly discloses that the invention "relates to a system enabling mobile customers to remotely place orders with any one of a group of affiliated merchants for pick up by the customer at a specific merchant location" (emphasis added) (*see* para. [0002] of Elston).

It is clear that Elston fails to disclose or suggest the above-mentioned features of claim 1. In particular, Elston fails to disclose a system that issues requested electronic goods and/or services.

For the final rejection, the Examiner argued that Elston discloses electronic goods and services by referring to the "multimedia objects". *See* Office Action, page 5:

The prior art by Elston teaches the inventory of the store that is housed in server(s), par. 81, which contains directory/databases. The databases show the multimedia objects inventory such as audio or video, par. 525.

Appellant respectfully disagrees. The multimedia objects disclosed in Elston do not constitute electronic goods and services that are provided as content by an electronic transaction system, e.g., as recited in claim 1. What Elston actually discloses on this point is that the “multimedia objects contain logos and trademarks (1040), introductory and general information (1046), including frequently asked questions, terms and conditions (1052) ...” (*see* paragraph [0519] of Elston).

Moreover, Elston itself makes clear that it does not encompass electronic goods and services. See, e.g., Elston, paragraph [0016]:

The invention consists of a complete remote ordering platform and method particularly suited for mobile or wireless commerce wherein a customer places an order with one physical outlet among a group of affiliated merchants for fulfillment and pick up by the customer at a specific merchant location.

[Emphasis added]

See also, Elston, paragraph [0059]:

The preferred embodiment of the invention is used to facilitate transactions between mobile customers wishing to place orders for fulfillment and pick up at one of several affiliated merchant locations. The mobile customer interfaces with

the system of the invention, implemented through one or more servers, and places the order with the system by means of a mobile wireless device. The affiliated merchant locations of the preferred embodiment are members of a franchise network of vendor locations where speed of service is of importance, such as for example a fast food dispensing restaurant, a chain of video rental stores, a chain of convenience stores, etc.

[Emphasis added]

The specific portions of Elston cited by the Office Action (at page 5) are set forth below for consideration. Paragraph [0081] of Elston recites the following:

The principal components identified above are preferably housed and executed on one or more servers dedicated to the RO system of the invention and remote from the merchant store locations. As noted below, many of the components may be implemented as distributed sub-systems.

In contrast with the Examiner's contention as to what paragraph [0081] of Elston discloses, the Appellant reads the paragraph to mean essentially that the principal components of the Elston Remote Order (RO) system are preferably hosted on one or more servers remote from the merchant store locations.

Paragraph [0525] of Elston recites the following:

a. multimedia objects (1096), which contain information of interest to customers and can include images, audio, video and text,

In contrast with the Examiner's contention as to what paragraph [0525] of Elston discloses, the Appellant reads the paragraph to mean essentially that the "store information directory 36 contains information required for customers to place remote orders to the specific store location" (paragraph [0519], last sentence) and this required information may include multimedia objects (paragraph [0525]) as information specific to a specific store (paragraph [0524]). Thus, Elston does not teach or suggest transacting electronic goods and/or services as recited in Appellant's claims, e.g., claim 1.

In addition, the Examiner has failed to indicate or make clear where Elston discloses or teaches each and every element as set forth in Appellant's claims.

For example, regarding claim 1, the Examiner has failed to indicate or make clear where Elston discloses or teaches the following elements:

- i. where the transaction application is operable to generate a user interface using the details and operable to generate a client request for one or more of the electronic goods and/or services;
- ii. whereupon the at least one transaction device issuing the generated client request to the host server the host server operates to generate a client response in reply to the client request;
- iii. in generating the client response, where necessary, issuing a service request to the at least one service provider system and receiving a service response from the at least one service provider; and

- iv. to issue the requested electronic goods and/or services.

Therefore, the anticipation rejection of claim 1 should be withdrawn since the Examiner has failed to indicate or make clear where Elston discloses every element of claim 1. Similarly, the anticipation rejections of the remaining claims (2-30) should be withdrawn at least by virtue of their dependency (either direct or indirect) from claim 1.

In addition, the Examiner has also failed to indicate or make clear where Elston discloses or teaches every element of at least the following dependent claims:

Claim 2 - “where the content management system references the matrix in determining the content to be provided to each transaction device of the at least one transaction device to ensure that the set of permissions and/or constraints are complied with”;

Claim 3 - “each dimension operable to record information in respect of the transaction device, electronic good or service or merchant, as appropriate, that may affect the content to be provided by the content management system”;

Claim 4 - “references the matrix in generating a client response to ensure that the set of permissions and/or constraints are complied with”;

Claim 5 - “the transaction device operable to check the set of unique identifiers against content already provided and request content having unique identifiers not already provided from the content management system”; and

Claims 6 to 8 and 14 to 26 - each claim in its entirety.

Accordingly, since Elston fails to disclose or teach each and every element of claim 1, Appellant respectfully submits that the rejection of claim 1 is without proper basis and should be withdrawn. Similarly, the anticipation rejections of the remaining claims should be withdrawn at least by virtue of their dependency (either direct or indirect) on claim 1.

In addition to Elston not forming a proper basis for a rejection of claims 1-30 under 35 U.S.C. § 102(e), Appellant submits that it would not have been obvious to a person of ordinary skill in the art to modify Elston to arrive at the claimed invention without impermissible hindsight. More specifically, Elston specifically teaches away from transacting electronic goods and services, as Elston specifically teaches that its invention is used to facilitate transactions between mobile customers wishing to place orders for fulfillment and pick up at one of several affiliated merchant locations. See, e.g., paragraphs [0002] and [0059] of Elston.

Based on at least the foregoing reasons, claim 1 is patentable over Elston. Claims 2-30 are patentable over Elston for at least the same reasons as claim 1. Based on the reasons described previously, the Appellant respectfully submits that the cited Elston reference forms an improper basis for a rejection of claims 1-30 under 35 U.S.C. § 102(e). Appellant therefore requests reversal of the rejection and allowance of the claims.

Conclusion

For all of the foregoing reason, Appellant respectfully submits that the rejections of the claims of the subject application are based on improper grounds and should be reversed. Appellant, therefore, respectfully solicits the Honorable Board to reverse the Examiner's rejections of the claims of the subject application under 35 U.S.C. § 102(e).

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made. Please charge the fees for a Petition for Extension of Time under 37 C.F.R. § 1.136, and any other required fees, to Deposit Account 501133 and please credit any excess fees to such deposit account.

Respectfully submitted,

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**Please recognize our Customer No. 23630
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CLAIMS APPENDIX

1. An electronic transaction system comprising:

a host server having an electronic inventory of electronic goods and/or services;

at least one transaction device having a transaction application;

at least one service provider system; and

a content management system,

where the content management system provides content in the form of details of electronic goods and/or services stored in the electronic inventory able to be transacted by the electronic transaction system to the at least one transaction device and where the transaction application is operable to generate a user interface using the details and operable to generate a client request for one or more of the electronic goods and/or services, where upon the at least one transaction device issuing the generated client request to the host server the host server operates to generate a client response in reply to the client request and in generating the client response, where necessary, issuing a service request to the at least one service provider system and receiving a service response from the at least one service provider, and to issue the requested electronic goods and/or services.

2. An electronic transaction system according to claim 1, further comprising a matrix recording a set of permissions and/or constraints applicable to the electronic transaction system, and where the content management system references the matrix in determining the content to be provided to each transaction device of the at least one transaction device to ensure that the set of permissions and/or constraints are complied with.

3. An electronic transaction system according to claim 2, where the matrix includes at least one of the following dimensions:

a transaction device dimension;

an electronic good or service dimension; and

a merchant dimension,

each dimension operable to record information in respect of the transaction device, electronic good or service or merchant, as appropriate, that may affect the content to be provided by the content management system

4. An electronic transaction system according to claim 2, where the host server determines whether the client request complies with the set of permissions and/or constraints recorded in the matrix and references the matrix in generating a client response to ensure that the set of permissions and/or constraints are complied with.
5. An electronic transaction system according to claim 1, where each transaction device of the at least one transaction device receives a set of unique identifiers from the host server, each unique identifier representing a component of the content, the transaction device operable to check the set of unique identifiers against content already provided and request content having unique identifiers not already provided from the content management system.

6. An electronic transaction system according to claim 5, where the transaction device is further operable to discard components of the content having a unique identifier not included in the set of unique identifiers received from the host server.
7. An electronic transaction system according to claim 5, where the unique identifier consists of a file name and at least one of the following: a version number; an error check value.
8. An electronic transaction system according to claim 1, where, upon creation of content using the content management system, the content management system operates to provide the content to each transaction device of the at least one transaction device.
9. An electronic transaction system according to claim 5, where the content includes, in respect of each electronic service and/or good able to be transacted; at least one of the following:
 - a description;
 - a graphic to represent the electronic service or good;
 - details of acceptable payment methods;
 - details of acceptable validation or data entry mechanisms; and/or
 - details of any document to be provided when the service response confirms a service request was successful.

10. An electronic transaction system according to claim 5, where the content includes at least one of the following:

a menu structure for navigating the electronic services and goods able to be transacted;

and

details of any security mechanisms implemented to control access to any restricted portions of the menu structure.

11. An electronic transaction system according to claim 5, where each transaction device of the at least one transaction device receives a scheduled time for transmission of content from the content management system, each transaction device operable to request the set of unique identifiers from the host server on the scheduled time.

12. An electronic transaction system according to claim 1, where the host server operates to generate a client response in reply to the client request by reference to a process model, the process model conceptually comprising a series of steps and links, the arrangement of one or more links in respect of a first step representing a second step to process on the first step resolving to a predetermined result in a set of predetermined results.

13. An electronic transaction system according to claim 12, where the set of predetermined results are a set of Boolean values and a fail result.

14. An electronic transaction system according to claim 1, comprising at least one channel grouping, each channel grouping associated with at least one transaction device, where

content provided to each transaction device of a channel grouping is the same as content provided to each other transaction device in the same channel grouping.

15. An electronic transaction system according to claim 1, comprising at least one relationship, each relationship recording details for facilitating communication between the host server and either a transaction device or a service provider system, using their respective native languages and communication protocols.
16. An electronic transaction system according to claim 1, wherein the electronic inventory is operable to provide an electronic good to the host server on request.
17. An electronic transaction system according to claim 16, where a request from the host server for an electronic good includes a goods identifier, the electronic inventory operable to provide an electronic good having a corresponding goods identifier in response to the request.
18. An electronic transaction system according to claim 16, where, on return of an electronic good to the electronic inventory, the electronic good is not able to be provided in response to a request from the host server for a predetermined period of time.
19. An electronic transaction system according to claim 16, where the electronic good is a serial number to be provided in redeeming an electronic service able to be transacted.
20. An electronic transaction system according to claim 1, where an asynchronous service request or asynchronous client request includes a correlation key and any response to the

asynchronous service request or asynchronous client request, as appropriate, includes the correlation key.

21. An electronic transaction system according to claim 20, where the host server is operable to distinguish between a service response and a client request by reference to the correlation key and/or type.
22. An electronic transaction system according to claim 1, where each service request, service response, client request and client response is communicated via at least one message bus.
23. An electronic transaction system according to claim 22, where at least one message bus uses a publish/subscribe mechanism of communication.
24. An electronic transaction system according to claim 1, where the transaction device includes at least one payment application.
25. An electronic transaction system according to claim 24, further comprising an intermediate router having a dedicated connection to the host server and to a payments host, the intermediate router operable to forward a service request issued by a transaction device to the host server and operable to forward a payment request issued by the payment application of the transaction device to the payments host.
26. An electronic transaction system according to claim 25, where the transaction device issues an authorisation request to the intermediate router for forwarding to the payments host and receives an authorisation reply from the payments host via the intermediate router and

where, if so authorised, the transaction system thereafter issues a service request to the transaction to the host server via the intermediate router and, upon receiving a service response indicating that the service request was successful, issuing a payment request to the payments host via the intermediate router.

27. An electronic transaction system according to claim 24, where the transaction device includes removable, writeable media for recording one or more of the following: a receipt; an electronic good; details of the client request; details of the client response.

28. An electronic transaction system according to claim 1, where the host server operates to confirm the identity and/or capacity of the transaction device that issued the client request and, if the identity of the transaction device can not be confirmed, or the capacity of the transaction device is exceeded, operable to ignore the client request.

29. A host server for use in an electronic transaction system according to claim 1.

30. A transaction device for use in an electronic transaction system according to claim 1.

31. A method of performing an electronic transaction comprising the steps of:

providing content in the form of details of electronic goods and/or services able to be transacted to at least one transaction device;

receiving a client request for one or more of the electronic goods and/or services detailed from a transaction device;

generating a client response in reply to the client request which, where necessary, includes issuing a service request to at least one service provider system and receiving a service response from the at least one service provider.

32. A method of performing an electronic transaction according to claim 31, including the step of referencing a matrix recording a set of permissions and/or constraints to ensure that the content to be provided to each transaction device complies with the recorded set of permissions and/or constraints.
33. A method of performing an electronic transaction according to claim 32, including the steps of determining whether the client request complies with the set of permissions and/or constraints recorded in the matrix and the step of generating a client response includes the sub-step of referencing the matrix to ensure that the set of permissions and/or constraints are complied with.
34. A method of performing an electronic transaction according to claim 31, including the step of sending a set of unique identifiers to each transaction device, each unique identifier representing a component of the content, and the step of transmitting any content having unique identifiers not already provided to the transaction device upon request by the transaction device.
35. A method of performing an electronic transaction according to claim 34, including the step of receiving a request for the set of unique identifiers from each transaction device at each transaction device's scheduled time.

36. A method of performing an electronic transaction according to claim 31, where the step of generating a client response includes the substep of executing a process model, the process model conceptually comprising a series of steps and links, the arrangement of one or more links in respect of a first step representing a second step to process on the first step resolving to a predetermined result in a set of predetermined results.
37. A method of performing an electronic transaction according to claim 31, including the step of associating each transaction device with at least one channel grouping, the content provided to each transaction device of a channel grouping being the same as content provided to every other transaction device in the same channel grouping.
38. A method of performing an electronic transaction according to claim 31, including the step of recording details for facilitating communication between the host server and each transaction device and the host server and each service provider system to form a set of relationships and the step of using the appropriate relationship in the set of relationships to facilitate communication between the host server and transaction device or service provider system, as appropriate, in their respective native languages and communication protocols.
39. A method of performing an electronic transaction according to claim 31, including the steps of issuing a request to an electronic inventory for an electronic good and receiving an electronic good from the electronic inventory.

40. A method of performing an electronic transaction according to claim 31, including the step of distinguishing between a service response and a client request by reference to a correlation key in the service response and/or type.
41. A method of performing an electronic transaction according to claim 31, including the step of communicating service requests, service responses, client requests and client responses by way of at least one message bus using a publish/subscribe mechanism of communication.
42. A method of performing an electronic transaction according to claim 31 , including the steps of confirming the identity and/or capacity of the transaction device that issued the client request and the step of ignoring the client request if the identity of the transaction device can not be confirmed or the capacity of the transaction device is exceeded.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.